

affect food products that already have the flavor of the flavoring agents and that the low amounts; i.e. 0.2%, of flavoring oils would not be expected to impart a greasy layer to the treated surfaces as argued by applicants. The Examiner states that no evidence has been provided to support Applicants' position.

Independent claims 31 and 34 contain the language "consisting essentially of" to a QAC and at least one solubility enhancing agent. This language allows the addition of water to the solution and other non-essential components that do not materially affect the properties of the claimed solution. From a review of Hall, beginning in col. 3, line 39 to col. 5, line 38, flavoring agents are "essential ingredients" in the oil-in-water emulsion of Hall, and all of the compositions disclosed in Hall contain a flavoring oil, which is an essential ingredient in these mouthrinse compositions.

Again, Applicants reiterate that the legal interpretation of the transitional phrase "consisting essentially of" in claims 31 and 34 and their dependent claims. In this regard when this phrase precedes a list of ingredients in a composition claim, the claim typically limits the scope of a claim to the specified materials or steps that "...do not materially affect the basic and novel properties of the claimed invention." (See *In re Herz*, 537 F.2d 549, 551-552 (CCPA 1976); Manual of Patent Examining Procedure (MPEP), Section 2111.03 (Original 8th Ed. 1998, August 2001, emphasis added). Particularly, on page 2100-50 (August 2001), 2nd column of the MPEP, it is stated that "[f]or purposes of searching for and applying prior art under 35 U.S.C. 102 and 103, absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, 'consisting essentially of' will be construed as equivalent to 'comprising.'" On page 8, lines 3-6 of the present specification, it is disclosed that the present solution does not contain flavoring oils. Applicants contend that this statement in the specification is a clear indication that no flavoring oils are present in the claimed solutions, and thus, following the instructions in the MPEP, the transitional phrase "consisting essentially of" cannot be construed as "comprising," as the Examiner has done.

As argued previously regardless of intended use, the claimed solution would be materially affected by the inclusion of a flavoring oil regardless of its low amounts (0.2%) as alleged by the Examiner. Applicants further contend that the inclusion of an oil, albeit a flavoring oil, in the claimed solution would materially affect its characteristic. For example, the flavoring oil could not be washed off by rinsing with water on any surface upon which it was used, thereby leaving a residual amount of flavoring oil, which Applicants contend

materially affects the basic and novel characteristics of the claimed solution as per the legal standard set forth in the MPEP discussed *supra*.

Upon the Examiner's acceptance of these arguments, Hall is not valid prior art to combine with Dickson, which cannot be present in claim 31. In regard to claim 34, this claim also contains the phrase "consisting essentially of." Therefore, the arguments regarding claim 31 above, also apply to claim 34.

For all of these reasons, Applicants believe that the inclusion of the flavoring oil in the claimed solutions of claims 31 and 34 would materially affect the basic and novel characteristics of the claimed invention. In view of the arguments above and in previous responses with regard to the Hall disclosure and the claim language "consisting essentially of," it is requested that the rejection based on Hall in view of Dickson be withdrawn with regard to rejected claims 31-35 and 37-39.

CONCLUSION

Reconsideration of the Examiner's rejection of claims 31-34 and 37-39 is kindly requested. It is believed that the above arguments place the application in condition for allowance, and a notice to that effect is respectfully requested. If there are any minor issues which can be taken care by telephone, it is requested that the Examiner contact the undersigned attorney at telephone number below.

Respectfully submitted,

Date

July 1, 2002

FOLEY & LARDNER

Customer Number: 22428



22428

PATENT TRADEMARK OFFICE

Telephone: (202) 672-5404

Facsimile: (202) 672-5399

By

Jayme A. Huleatt

Jayme A. Huleatt

Attorney for Applicant

Registration No. 34,485